Remarks

Reconsideration of the above referenced application in view of the enclosed amendment and remarks is requested. Existing claims 1 – 16 remain in the application. Claim 9 is amended to correct a typographical error which does not change the meaning or scope of the original claim. Claims 17 – 20 are added to recite further embodiments of the disclosed invention. Claims 1 – 20 are now pending in the application.

ARGUMENT

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,418,138 to Cerf et al. (hereinafter Cerf et al.) in view of U.S. Publication 2001/0013052 to Benjamin et al. (hereafter Benjamin et al.). This rejection is respectfully traversed and Claims 1-16 are believed allowable based on the following discussion.

The Examiner's use of Benjamin et al. is improper. The filing date of Benjamin et al. is after the filing date of Applicants' application. Thus, the Examiner must rely on Provisional Application to Benjamin et al. (60/243,218) for support. MPEP § 2141.01 states that prior art available under 35 U.S.C. § 102 is available under 35 U.S.C. § 103. Thus, we must look at 35 U.S.C. § 102(e) to determine whether Benjamin et al. is an appropriate reference. MPEP § 706.02(f)(1), Example 2, states, in part:

> "For reference publications and patents of patent applications filed under 35 U.S.C. 111(a), the prior art dates under 35 U.S.C. 102(e) accorded to these references are the earliest effective U.S. filing dates. Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims priority under 35 U.S.C. 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under 35 U.S.C. 102(e), ***assuming the earlier-filed application has proper support for the subject matter as required by 35 U.S.C. 119(e) or 120***." (emphasis added).

Thus, Applicants respectfully request that the Examiner withdraw the rejection using Benjamin et al. as a reference and that the Examiner cite the relevant portions of the Provisional Application 60/243,218, if any, as support for the prior art reference. Until such time as the Provisional

Application is cited and forwarded to Applicants, this rejection remains unsupported, and hence, improper. Thus, Applicants refrain from making specific arguments regarding the Benjamin et al. reference until the Examiner shows support in the Provisional Application for the recited limitations.

Assuming that Benjamin et al. does find support in the Provisional Application as a prior art reference under 35 U.S.C. § 103(a), this rejection is still improper based on the following discussion.

Cerf et al. generally teach a novel communication system including mobile units distributed within a wireless communication network which are connected to a packet switched network (e.g., the Internet) via a proxy server. The proxy server converts unicast data packets coming from the packet switched network to multicast data packets being transmitted to the mobile units, and is also responsible for the overall management and control of the communication system. In contrast, Applicants' Claims 1-4 require *a cache device configured to communicate wirelessly with the portable wireless communication appliance and to communicate with the remote device, the cache device storing a copy of a predetermined portion of the database*. Cerf et al. do not teach a cache device in Figure 2 and Col. 3, lines 15-27, as asserted by the Examiner. The Examiner has equated Applicants' cache device with a proxy server taught by Cerf et al.

Cerf et al. teach a proxy server (16) which provides a variety of control mechanisms and management functions of the communication system (Col. 3, lines 30-32). The proxy server, as taught by Cerf et al. continuously receives information *from* the source (remote device) of the Internet for a predetermined list of channels. (Col. 4, lines 29-31). The proxy server taught by Cerf et al. is typical of other proxy servers. The proxy server is meant to store information from a remote device (Internet) until such time as the user (portable device or personal computer) wishes to display or download the information. Thus, any data cached in the proxy server taught by Cerf et al. is downloaded from the source (remote device) and waits for retrieval by the user. This is contrary to the cache device which is recited in Applicants' claims.

Applicants' cache device may store information *from* the user (portable device) until such time as the remote device become available. For instance, a user may update large amounts of information to be synchronized with a database on a remote device, but the remote device may

not always be available. Further, the user may desire to uncouple the portable wireless communication appliance from the cache device, i.e., take the portable device to another location, and enable the remote database to be updated as soon as the remote device becomes available. This capability is not possible using the teachings of Cerf et al. Cerf et al. teach away from Applicants' invention. Applying the teachings of Cerf et al. would enable the portable wireless communication device to retrieve cached information from remote device, but would not enable the portable device to upload information or portions of a database to the remote device via the cache device, especially when the portable device is no longer in communication with the cache device.

Further, regarding Claims 5-16, the Examiner asserts that Cerf et al. *implicitly* disclose determining if the remote device is available for communication with the cache device, citing col. 5, lines 58-67, col. 6 , lines 1-3 and 32-41. This assertion is improper, as the cited reference does not explicitly show the recited limitation. The Examiner asserts that because the proxy of Cerf et al. has "many different control mechanism and management functions" that Cerf et al. "at least implicitly disclose determining if the remote device is available..." The Examiner makes an improper assumption. There is no explicit or implicit disclosure of the recited limitation. In fact, Cerf et al. teach a specific sequence of steps to include denying access to the remote device if the subscription is invalid (Col. 6, lines 3-5). Cerf et al. teach only that the subscription is invalid or the serial number of the Internet radio is invalid. At no time do Cerf et al. discuss whether the remote device is unavailable. Similarly, Cerf et al. do not implicitly or explicitly disclose accessing the database when the remote device is available or monitoring the availability of the remote device. Thus, all claims remaining in the application are now allowable.

CONCLUSION

In view of the foregoing, Claims 1 – 20 are all in condition for allowance. If the Examiner has any questions, the Examiner is invited to contact the undersigned at (703) 633-6845. Early issuance of Notice of Allowance is respectfully requested. Please charge any shortage of fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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